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U.S. Application No. 09/923,320 Examiner NGUYEN Art Unit 2154  
Response to January 26, 2007 Office Action

### **REMARKS**

In response to the Office Action dated January 26, 2007, the Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited documents of record.

Claims 1, 3-48, and 51-54 are pending. Claims 1, 11-16, 19, 20, 24, 27-30, 34, 37- 40, 42, 44, 47, 48, and 51-54 are amended. Support for the amendments is found throughout the Specification, as at paragraphs [0051] and [0065], for example. No new matter is submitted. Accordingly, entry and consideration of the amendments are respectfully requested.

The United States Patent and Trademark Office (the "Office") rejects claims 1, 20, 30, 40, 42, and 48 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. The Office rejects claims 1, 3-48 and 51-54 under 35 U.S.C. § 112, second paragraph as allegedly indefinite. The Office rejects claims 1, 5-20, 23-29 (understood to include claim 30 too because the body of the rejection refers to claim 30, which is nowhere else rejected in the Office Action), 33-40, 42, 44, 46-48 and 51-54 under 35 U.S.C. § 103 (a) as allegedly unpatentable over U.S. Patent 6,728,754 to Lipton in view of U.S. Patent Application Publication 2002/0032631 to Rose. The Office rejects claims 3, 4, 21, 22, 31-32, (understood to include claims 41 and 43 too because the body of the rejection refers to claims 41 and 43, which are nowhere else rejected in the Office Action) and 45 under 35 U.S.C. § 103 (a) as allegedly unpatentable over *Lipton* and *Rose* in view of U.S. Patent 6,021,433 to Payne *et al.*

The Assignee shows, however, that the pending claims are patentably distinguishable over *Lipton*, *Rose* and *Payne*, whether considered alone or in any combination.

### **Telephone Interview**

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The Assignee appreciates the courtesies extended by Examiner Nguyen in conducting the telephone Interview of March 13, 2007. The Assignee's record of this telephone interview is constituted by the amendments and remarks submitted herewith. During the Interview agreement was reached that the amendments submitted herewith obviate the 35 U.S.C. § 112, second paragraph, rejection of claims 1, 3-48 and 51-54 cited in the Office Action. During the Interview, the Assignee explained that the usefulness of monitoring online users until the preset criteria is met, as generally recited in each pending independent claim, is self-evident, thereby obviating the alleged 35 U.S.C. § 101 lack of utility rejection. During the Interview, it was further agreed that the features of *"monitoring a total number of users who log in to a website; ...comparing the total number of users to notification criteria of the offline user, the notification criteria specifying a preset amount of users...; and when the total number of users exceeds the preset amount, then sending a notification to the offline user,"* as generally recited in each pending independent claim 1, 20, 30, 40, 42, 48 and 51, distinguishes over the applied references to *Lipton* and *Rose*. As explained further herein, the remaining reference to *Payne* is silent with respect to these features and thus fails to overcome the deficient combination of *Lipton* and *Rose* in at least this regard.

#### **Rejection of Claims under 35 U.S.C. § 101**

The Office rejects pending independent claims 1, 20, 30, 40, 42, 48 and 51 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. The Assignee respectfully traverses this rejection and submits that the usefulness of each pending independent claim is self-evident.

A rejection based on lack of utility should not be imposed if, at any time, during examination of the application the usefulness of the claimed invention is well-established. *See*, DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2107 (II) (A) (3) (8<sup>th</sup> Edition) (hereafter "MPEP"). An invention has a well-established utility if "(i) a person of ordinary skill in the art would immediately appreciate why the invention is useful based on the characteristics of the invention...; and (ii) the utility is specific, substantial and credible." *Id.*

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Moreover, if the applicant has asserted that the claimed invention is useful for any particular practical purpose, then a lack of utility rejection should not be imposed. *Id.* at § 2107 (II) (B) (1). In this case, the Assignee asserts that the pending claims are self-evidently useful, as explained in further detail immediately below. Thus, the 35 U.S.C. § 101 lack of utility rejection should be removed.

In particular, claim 1 generally recites a method for notifying an offline user of the existence or activities of online users based on notification criteria of the offline user, the notification criteria specifying a preset amount of users that log in to the website, wherein the method comprises, *inter alia*, “when the total number of users exceeds the preset amount, then sending a notification to the offline user, wherein the notification informs the offline user of an amount of activity in the website.” Independent claims 20, 30, 40, 42, 48 and 51 recite similar features. Contrary to the lack of usefulness asserted in the Office Action, the usefulness of the pending claims is self-evident, particularly in view of the Specification at paragraph [0054] and Figure 2, step 204, for example, wherein the continued monitoring of online users is explained as occurring periodically or continuously when the offline user’s notification criteria is not met. The periodic or continuous monitoring of the online users thus continues until the notification criteria is met, whereafter notification to the offline user is sent informing that the offline user’s notification criteria has been met. Monitoring the online users until the notification criteria is met fulfills the statutory requirement of usefulness, in addition to the use of notifying an offline user when the notification criteria has been met as determined by the monitoring. Each of pending independent claims 1, 20, 30, 40, 42, 48 and 51 recite such features and thus fully comply with the statutory requirements of 35 U.S.C. §101. Accordingly, withdrawal of the 35 U.S.C. §101 rejection of claims 1, 20, 30, 40, 42, 48 and 51 is respectfully requested.

#### **Rejection of Claims under 35 U.S.C. § 112**

The Office rejects claims 1, 3-48 and 51-54 under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness with respect to the relationship between “a particular number of user” and “a preset amount” as recited in pending independent claims 1, 20, 30, 40, 42, 48 and 51. The

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independent claims have all been amended to recite "preset amount" throughout. As the Examiner agreed during the interview, the pending claims thus fully comply with the patent laws, and withdrawal of the 35 U.S.C. § 112, second paragraph, rejection of claims 1, 3-48 and 51-54 is respectfully requested.

**Rejection of Claims under 35 U.S.C. § 103 (a)**

Claims 1, 5-20, 23-29 (and presumably claim 30), 33-40, 42, 44, 46-48 and 51-54 were rejected under 35 U.S.C. § 103 (a) as allegedly unpatentable over U.S. Patent 6,728,754 to Lipton in view of U.S. Patent Application Publication 2002/0032631 to Rose. Claims 3, 4, 21, 22, 31, 32, (presumably claims 41 and 43), and 45 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Lipton* and *Rose* in view of U.S. Patent 6,021,433 to Payne *et al.*

The rejections are respectfully traversed for at least the reasons set forth hereinbelow.

**1. Because the Combination of *Lipton* and *Rose* Fails to Teach or Suggest All the Claimed Features, the *Prima Facie* Case Must Fail**

As the Examiner agreed during the interview, the combination of *Lipton*, *Rose*, and/or *Payne* cannot obviate the pending claims. To establish a *prima facie* case of obviousness, the Office must show that all the claimed limitations are taught or suggested. See MPEP at § 2143. Here, however, the combined teaching of *Lipton*, *Rose*, and/or *Payne* fails to teach or suggest all of the features of claims 1, 20, 30, 40, 42, 48 and 51, which are set forth in full above and discussed in pertinent part below.

The combined teaching of *Lipton*, *Rose*, and/or *Payne* cannot obviate the pending claims. The pending claims recite, or incorporate, features that are not taught or suggested by *Lipton*, *Rose*, and/or *Payne*. Independent claim 1, for example, recites "*monitoring a total number of users who log in to a website; ...comparing the total number of users to notification criteria of the offline user, the notification criteria specifying a preset amount of users...; and when the*

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*total number of users exceeds the preset amount, then sending a notification to the offline user."*

Independent claims 20, 30, 40, 42, 48 and 51 recite similar features. The combined teaching of *Lipton*, *Rose*, and/or *Payne* is entirely silent to all these features.

*Lipton* discloses a method of notifying members of a group of the online status of a user. U.S. Patent 6,728,754 to *Lipton* (April 27, 2004) at column 1, lines 54-57. The group in *Lipton* may be a "buddy list." *Id.* at column 2, lines 16-23. Notification to the group, or any members thereof, is sent at the discretion of the initial online user, who specifically enables or disables the notification option. *Id.* at column 2, lines 7-12. Thus, though the method of *Lipton* may determine if a member of the group, *i.e.*, "buddy list," is online, nothing in *Lipton* teaches or suggests "*monitoring a total number of users who log in to a website; ...comparing the total number of users to notification criteria of the offline user, the notification criteria specifying a preset amount of users...; and when the total number of users exceeds the preset amount, then sending a notification to the offline user,*" as generally recited in the pending independent claims. The Office Action even concedes that *Lipton* does not disclose this combination of features.

*Rose* is allegedly applied to overcome the deficiencies of *Lipton*. *Rose*, however, fails to do so. Rather, *Rose* discloses a remote call-to-action messaging system and method for alerting a user when a predetermined event occurs. U.S. Patent Publication 2002/0032631 to *Rose* (March 14, 2002) at Abstract and paragraph [0015]. *Rose* explains, in the context of an auction, that when a predetermined event has occurred (such as a higher bid), a user is alerted. *Id.* at paragraphs [0021]-[0023]. *Rose* further explains that other "predefined events" may be "special short-term offers for sale, or electronic mail messages to which a response is required. *Id.* at paragraph [0022]. Thus, although *Rose* alerts a user of higher bids in order to allow a user to respond with a subsequent bid, *Rose* does not teach or suggest "*monitoring a total number of users who log in to a website; ...comparing the total number of users to notification criteria of the offline user, the notification criteria specifying a preset amount of users...; and when the total number of users exceeds the preset amount, then sending a notification to the offline user,*" as is recited in each of the pending independent claims.

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*Payne* is similarly silent to all these features. *Payne* describes different multimedia alerts for incoming messages. A user may then obtain more detailed information, if desired. See U.S. Patent 6,021,433 to *Payne et al.* (Feb. 1, 2000) at Abstract and at column 8, lines 25-end.

Thus, *Lipton*, *Rose*, and/or *Payne* are entirely silent to all these features. Because the combined teaching of *Lipton*, *Rose*, and/or *Payne* fails to teach or suggest many features of the independent claims, one of ordinary skill in the art would not think that the pending claims are obvious. The alleged 35 U.S.C. § 103 (a) rejection of claims 1, 5-20, 23-29, 33-40, 42, 44, 46-48 and 51-54, based on the combination of *Lipton* with *Rose*, must fail. Likewise, the §103(a) rejection of claims 3, 4, 21, 22, 31, 32 and 45, based on the combination of *Lipton*, *Rose* and *Payne*, must also fail. Accordingly, withdrawal of the 35 U.S.C. 103 (a) rejections of the pending claims is respectfully requested.

**2. Because No Reasonable Expectation of Success was Cited, the *Prima Facie* Cases Are Defective**

The Examiner's alleged *prima facie* cases are defective. A *prima facie* case for obviousness must include "a reasonable expectation of success." MPEP at § 2143. Here, however, the Office Action has provided no basis for successfully combining *Lipton*, with either of *Rose* or *Payne*, to provide a method, computer or system comprising, inter alia, "*monitoring a total number of users who log in to a website; ...comparing the total number of users to notification criteria of the offline user, the notification criteria specifying a preset amount of users....; and when the total number of users exceeds the preset amount, then sending a notification to the offline user,*" as is generally recited in each of the pending independent claims. All other claims ultimately depend from one of the pending independent claims 1, 20, 30, 40, 42, 48 and 51. Because the Office has entirely failed to make such a finding, the Office has failed to properly establish a *prima facie* case for obviousness. Due Process thus demands that the Office withdraw the 35 U.S.C. §103(a) rejections of claims 1, 3-48 and 51-54.

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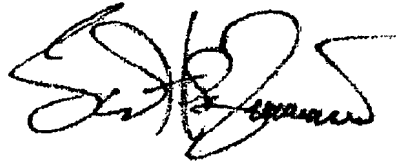
**CONCLUSION**

In view of the above, the Assignee submits that all pending claims are patentable. Accordingly, a prompt Notice of Allowance of claims 1, 3-48 and 51-54 is respectfully solicited.

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If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 469-2629 or [scott@scottzimmerman.com](mailto:scott@scottzimmerman.com).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

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